

REMARKS

In the Office Action of October 9, 2008, claims 30-32 were rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claim 26 of U.S. Patent No. 5,852,741, claim 10 of U.S. Patent No. 5,787,302, claim 10 of U.S. Patent No. 5,826,054, and claim 3 of U.S. Patent No. 5,878,267. In addition, claims 30-32 were rejected under 35 U.S.C. 112, second paragraph, because claim 30 recites “*a stream of stored instructions*” and claims 31 and 32 recite “*the medium,*” which allegedly lacks antecedent basis. Furthermore, claims 30-32 were rejected under 35 U.S.C. 101. Claims 30-32 were also rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 5,500,942 (“Eickemeyer et al.”). In addition, claims 30-32 were also rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 5,632,024 (“Yajima et al.”) in view of U.S. Patent No. 5,057,837 (“Colwell et al.”) and U.S. Patent No. 4,858,104 (“Matsuo et al.”).

With respect to the obviousness-type double patenting rejections of claims 30-32, Applicants will address these rejections once the pending claims are indicated as being allowable, assuming that these rejections are still applicable.

With respect to the Section 101 and 112 rejections of claims 30-32, Applicants have amended these claims according to the kind suggestions made by the Examiner to overcome these rejections. Thus, Applicants respectfully request that these rejections be withdrawn.

With respect to the Section 102 and 103 rejections of claims 30-32, Applicants respectfully assert that the amended independent claim 30 is neither anticipated by Eickemeyer et al. nor obvious in view of Yajima et al., Colwell et al. and Matsuo et al., as explained below. In view of the claim amendments and the following remarks, Applicants respectfully request the allowance of pending claims 30-32.

I. Patentability of Amended Independent Claim 30

The amended independent claim 30 was rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Eickemeyer et al. and under 35 U.S.C. 103(a) as allegedly being obvious in view of Yajima et al., Colwell et al. and Matsuo et al. However, the cited references fail to disclose each limitation of the amended independent claim 30. Thus, the amended independent claim 30 is neither anticipated by Eickemeyer et al. nor obvious in view of Yajima et al., Colwell et al. and Matsuo et al.

A. Patentability of Amended Independent Claim 30 Under U.S.C. 102(e)

The independent claim 30 recites in part “*a first instruction including a format field that specifies an instruction compression format,*” which is not disclosed in the cited reference of Eickemeyer et al. Thus, the independent claim 30 is not anticipated by the cited reference of Eickemeyer et al.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Office Action on pages 6 and 7 alleges that the cited reference of Eickemeyer et al. in column 13, lines 20-22, discloses the claim limitation of “*a first instruction including a format field that specifies an instruction compression format,*” as recited in claim 30. The cited passage of Eickemeyer et al. describes a first instruction that begins with the first byte having a length field that indicates the beginning of the next instruction. However, Eickemeyer et al. does not disclose (in the cited passage or elsewhere) that the first instruction includes any field “*that specifies an instruction compression format,*” as recited in claim 30. In fact, there is no mention of “compression” anywhere in the cited reference of Eickemeyer et al. Thus, Eickemeyer et al. fails to disclose “*a first instruction including a format field that specifies an instruction compression format,*” as recited in the amended

independent claim 30. Thus, the amended independent claim 30 is not anticipated by cited reference of Eickemeyer et al.

B. Patentability of Amended Independent Claim 30 Under U.S.C. 103(a)

The claim limitation of “*a first instruction including a format field that specifies an instruction compression format*” is also not disclosed in the cited references of Yajima et al., Colwell et al. and Matsuo et al. Thus, the amended independent claim 30 is not obvious in view of these references.

The Office Action on page 8 alleges that the cited reference of Colwell et al. in column 2, lines 5-19, column 14, lines 65-68, and column 15, lines 1-19 and 38-40, discloses the claim limitation of “*a first instruction including a format field that specifies an instruction compression format,*” as recited in claim 30. The cited reference of Colwell et al. describes in column 14, lines 65-68, and column 15, lines 1-9, an instruction word having thirty-two bit fields with an associated mask word, where each bit of the mask word is associated with one of the thirty-two fields of the instruction word such that for each zeroed field, the corresponding bit of the mask word is zeroed, while for other fields, the corresponding bit of the mask word is set to one. As further described in column 15, lines 38-40, the zeroed fields are not stored and the mask words are employed. However, none of these thirty-two fields of the instruction word “*specifies an instruction compression format,*” as recited in claim 30. The fields of the instruction word correspond to different operations, as described in column 14, lines 40-64, of Colwell et al., which could be zeroed. None of the zeroed fields of the instruction word “*specifies an instruction compression format,*” as recited in claim 30. Thus, the cited reference of Colwell et al. fails to disclose “*a first instruction including a format field that specifies an instruction compression format,*” as recited in claim 30. The other cited references of Yajima et al. and Matsuo et al. also fail to disclose such limitation of claim 30.

Since the claim limitation of “*a first instruction including a format field that specifies an instruction compression format*” is not disclosed in any of the cited references of Yajima et al., Colwell et al. and Matsuo et al., the amended independent

claim 30 cannot be derived even if the teachings of Yajima et al., Colwell et al. and Matsuo et al. are combined. As such, the amended independent claim 30 is not obvious in view of Yajima et al., Colwell et al. and Matsuo et al.

II. Patentability of Amended Dependent Claims 31 and 32

Each of the amended dependent claims 31 and 32 depends on the amended independent claim 30. As such, these dependent claims include all the limitations of the amended independent claim 30. Therefore, Applicants submit that these dependent claims are allowable for the same reasons as the amended independent claim 30. Furthermore, these dependent claims may be allowable for additional reasons.

Applicants respectfully request reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,
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